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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,990	02/26/2007	Himanshu Brahmbhatt	060348-0145	1926
22428	7590	10/14/2008		
FOLEY AND LARDNER LLP			EXAMINER	
SUITE 500			SINGH, ANOOP KUMAR	
3000 K STREET NW				
WASHINGTON, DC 20007				
			ART UNIT	PAPER NUMBER
			1632	
			MAIL DATE	DELIVERY MODE
			10/14/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,990

Applicant(s)

BRAHMBHATT ET AL.

Examiner

Anoop Singh

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Interpretation: Claim 35 is directed to “use” of bacterially derived intact minicell. These claims are indefinite since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. Additionally, because these claims fails to set forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim. For the sake of compact prosecution, the Examiner has interpreted claim 35 to be methods of using minicell in treating disease. If Applicants do not wish for these claims to be interpreted as methods of using minicell in the treatment, Applicants are invited to amend the claims, at which point, the Examiner will determine if the amended claims fall within the elected group.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-18 and 35, drawn to a method for targeted gene delivery to produce an expression product of the therapeutic nucleic acid sequence and method of using bacterially derived intact minicell for treating a disease.

Group II, claims 19-34, drawn to a composition comprising (i) a bacterially derived minicell that contains a therapeutic nucleic acid molecule and (ii) a bispecific ligand that is capable of binding to a surface component of said minicell and to a surface component of a non-phagocytic mammalian cell.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: In the instant case, the technical feature linking group I-II is a bacterially active minicell containing a therapeutic nucleic acid. Surber et al (US 2003/0203481, IDS) teach use of a bacterially derived minicell to deliver construct comprising nucleic acid encoding a therapeutic protein to mammalian cells (see para. 697). It is noted that Surber et al specifically suggest using bi specific ligands (para. 106 and para. 497). Similarly, Sabbadini et al (US Patent 7,183,105, dated 2/27/2007, effective filing date 5/24/2001) teach a composition comprising an intact minicell that contains a functional nucleic acid. Sabbadini et al. teach that nucleic acids of the invention can be delivered by minicells containing plasmids or expression vectors comprising sequences encoding the nucleic acids, wherein the expression constructs comprise regulatory elements operably linked to a nucleotide sequence that serves as a template for a bioactive nucleic acid (see column 7). Sabbadini et al. teach a method of delivering a biologically active compound to a cell, wherein the cell displays a ligand specifically recognized by a binding moiety, comprising contacting the cell with a minicell that displays the binding moiety, wherein the minicell comprises the biologically active compound, and wherein the contents of the minicell are delivered into the cell from a minicell bound to the cell. The binding moiety can be directed to various types of ligands. Furthermore, Sabbadini et al. teach that the ligand is a compound, composition, or moiety that is capable of being specifically bound by a binding moiety, including without limitation a receptor and an antibody (see column 34). Consequently, it would have been obvious for one of ordinary skill in the art to deliver gene by bringing bispecific ligand into contact with mini cell comprising nucleic acid and non phagocytic mammalian cell to produce expression product of such therapeutic gene. Therefore, the instant technical feature does not contribute over prior art.

In addition, the inventions are distinct, each from other because of the following reasons: Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the composition comprising minicell may be used in other process such as transfecting mammalian cell for screening candidate agent. Accordingly, searching for distinct method steps and composition will not be coextensive and will require separate and independent searches in the patent and non-patent literature.

Each invention is directed to distinct goal, which comprises the use bacterium, virus or cell in order to achieve its respective and intended objective. Thus, it follows from the preceding analysis that the claimed inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the reasons set forth above.

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

bispecific ligand is a polypeptide or carbohydrate

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any

claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner: claims 1 and 20, and claims dependent therefrom correspond to all the species listed above.

The following claim(s) are generic: claims 1 and 20.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: since each disclosed species do not share a common structure feature in common with respect to their binding efficacy of minicell to mammalian cell. Thus, requirement of unity of invention is not fulfilled.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anoop Singh whose telephone number is (571) 272-3306. The examiner can normally be reached on 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571) 272- 4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anoop Singh
AU 1632

/Thaian N. Ton/
Primary Examiner, Art Unit 1632